



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/822,978

03/30/2001

Paul E. Bender

010190

8948

23696

7590

11/02/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

WAHBA, ANDREW W

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,978	Applicant(s) BENDER ET AL.	
	Examiner Andrew W Wahba	Art Unit 2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/30/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



PHIRIN SAM
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the applicant claims "said packet being transmitted during a first time period" (line 4) and "said packet being transmitted during a first time period" (lines 5-6). The Office is unclear as to the difference between the claimed "packet" and "message". Claims 6, 11, 16, 21, 26, 28, 30, 32, and 33 have a similar issue.

With further regard to claim 1, the applicant claims "monitoring at said access terminal said control channel based on a relationship between said message and a previous message" (lines 10-11). First, the office is unclear as to the relationship between the two messages. The applicant is requested to point to areas in the specification that describe this relationship. Second, since the message is transmitted in the first time period (lines 5-6), the applicant is advised to indicate when the previous message is transmitted. Claims 6, 11, 16, 21, 26, 28, 30, 32, and 33 have a similar issue.

With regard to claim 2, the applicant claims "wherein said message is linked to said set of overhead parameters" (lines 1-2). The manner in which the message is

Art Unit: 2661

linked to the overhead parameters is not clear. The applicant is advised to reference areas in the specification that describe this link. Claims 7, 12, 17, 22, 27, 29, 31 have a similar issue.

With regard to claim 5, the applicant claims "monitoring said control channel until said message matches said previous message, if said message indicates that said message indicates that said set of overhead parameters is not up to date" (lines 2-4). In this limitation said message indicates that overhead parameters are not up to date. The limitation proceeds to monitor the control channel so as to locate a match between the message and previous message. The manner in which monitoring the control channel begins is not understood, as said message has already been received. Claims 5, 10, 15, 20 and 25 have a similar issue.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-9, 11-14, 16-19, 21-24 and 26-33 are rejected under 35

U.S.C. 102(e) as being anticipated by Butler et al (US Patent 6,111,865).

With regard to claims 1, 6, 11, 16, 21, 26, 28, 30, 32, and 33, Butler et al discloses a quick page message (previous message) transmitted from a base station (access network) in a quick page slot (second time period) and a full page message (packet / message) transmitted in a full page slot (first time period) assigned to the wireless terminal (access terminal) (column 4, lines 16-20). The wireless terminal activates additional decoding circuitry (monitoring) in response to the quick page message prior to the full page slot (column 4, lines 22-26). Butler et al further discloses that multi-bit quick paging messages may be used to convey additional information (overhead parameters) (column 5, lines 43-54).

With regard to claims 2, 7, 12, 17, 22, 27, 29 and 31, Butler et al discloses that multi-bit quick paging messages may be used to convey additional information (overhead parameters) (column 5, lines 43-54). Butler et al discloses that the multi-bit quick paging message can be used to indicate (linked) that the full paging channel (message) should be performed for a longer duration (column 5, lines 50-54).

With regard to claims 3, 8, 13, 18 and 23, Butler et al discloses that multi-bit quick paging messages may be used to convey additional information (overhead parameters) (column 5, lines 43-54). The wireless terminal activates additional decoding circuitry (monitoring) in response to the quick page message prior to the full page slot (column 4, lines 22-26). It is inherent that the additional information would be current or "up to date" (line 2) otherwise such information would serve no function. For example, Butler et al discloses that the multi-bit quick paging message can be used to

indicate that the full paging channel (message) should be performed for a longer duration (column 5, lines 50-54).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4, 9, 14, 19 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al (US Patent 6,111,865) in view of Yli-Kotila et al (US Patent 5,539,925).

With regard to claims 4, 9, 14, 19 and 24, Butler et al discloses a quick page message (previous message) transmitted from a base station (access network) in a quick page slot (second time period) and a full page message (packet / message) transmitted in a full page slot (first time period) assigned to the wireless terminal (access terminal) (column 4, lines 16-20). The wireless terminal activates additional decoding circuitry (monitoring) in response to the quick page message prior to the full page slot (column 4, lines 22-26). Butler et al further discloses that multi-bit quick paging messages may be used to convey additional information (overhead parameters) (column 5, lines 43-54).

Butler et al does not teach or fairly suggest access terminal entering a sleep mode at the end of the first time period if the message matches a previous message.

Yli-Kotila et al discloses a turn-off message transmitted to a radio telephone MS at the end of each signaling burst (end of first time period) transmitted by the base station (BS). The turn-off message permits the radio telephone MS to turn off unnecessary power-consuming portions for a turn-off period (sleep mode) indicated by the message (column 3, lines 57-62).

A person of ordinary skill in the art would have been motivated to employ Yli-Kotila et al in Butler et al to as to consume less power in a standby mode thereby extending the battery life of the mobile unit (Butler et al, column 8, lines 4-7). At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Butler et al and Yli-Kotila et al so as to obtain the invention as specified in claims 4, 9, 14, 19 and 24.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W Wahba whose telephone number is (571) 272-3081. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth N Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2661

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Wahba 

October 28, 2004


PHIRIN SAM
PRIMARY EXAMINER